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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/621,223 07/21/00 AYDUB

A 3845-4001

EXAMINER

MM91/0828

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SCHWARTZ, I

ART UNIT

PAPER NUMBER

2873

DATE MAILED:

08/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/621,223

Applicant(s)

AYOUB, ABBY

Examiner

Jordan M. Schwartz

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2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Specification***

The specification is objected to because it does not include a reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

### ***Claim Objections***

Claims 13 and 16 are objected to for the following reasons. Since the intended meaning could be determined, 112 rejections were not made but instead these lack of clarity issues were raised in claim objections.

In reference to claims 13 and 16, "the heat source" lacks an antecedent basis. For purposes of examination it is assumed that claims 13 and 16 each depend from claim 12 i.e. "further comprising placing the lens under a heat source" and further clarity is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4-5, 7-10, 12-13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al.

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Brown et al reads on these claims by disclosing the limitations therein including the following: an apparatus (abstract re eyeglasses); comprising a lens (abstract); a coating affixed to at least a portion of the edge of the lens (abstract); the coating as colored (column 5, line 51 re "slightly colored materials"). Furthermore, the lenses are immersed in a dye bath (column 5, lines 12-23), which will inherently color the entire lens including "at least a portion of the edge". Brown et al further discloses the coloring as translucent (column 5, line 52); and the lens affixed to an eyeglass frame (abstract). Eyeglass frames inherently have some color, this being reasonably based upon the well known use of colored eyeglass frames. The "slightly colored materials" for the edge coating will inherently not match the eyeglass frame color, this being reasonably based upon the coatings as "slightly colored" while eyeglass lens frames are generally more than slightly colored. Brown et al further discloses that the coating is not affixed to the face of the lens (column 5, line 56); a method of applying the coating to at least a portion of the edge of the lens (column 5, line 56); placing the lens under a heat source and a UV heat source (column 4, line 32 and column 5, lines 40-63); and allowing the coating to dry before placing the lens under the heat source (column 5, lines 40-63). The method of Brown et al would inherently remove any excess coating from the face of the lens, this being reasonably based upon Brown et al disclosing the coating being applied to the edge of the lens through a paint brush and not to the face of the lens (column 5, line 56), similar to that of the claimed invention.

Claims 1, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Wertheim.

Wertheim reads on these claims by disclosing the limitations therein: an apparatus (Figures 1 and 2, abstract); comprising a lens (column 2, lines 37-57); a colored coating being affixed to the lens (column 2, line 50); and placing the lens under a heat source (column 2, line 37 to column 3, line 14). At least a portion of the edge of the lens will inherently be colored, this being reasonably based upon Wertheim disclosing that the entire lens is lowered into the dye solution i.e. that the entirety of the lens will be colored (column 2, line 50).

Claims 1-2, 4-5, 9 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ono et al.

Ono et al reads on these claims by disclosing the limitations therein: an apparatus (column 1, line 16 and column 11, line 32 re "eyeglasses"); comprising a colored coating being affixed to the lens (column 1, lines 15-31, column 9, line 54 re "dipping method"). At least a portion of the edge of the lens will inherently be colored, this being reasonably based upon Ono et al disclosing that the entire lens is lowered into the dye solution i.e. that the entirety of the lens will be colored (column 1, line 29, column 9, line 54). Ono et al further discloses that the lens can be imparted with a scratch-resistant coating (column 5, line 40); and placing the lens under a heat source (column 1, line 29).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al in view of Burzynski.

Brown et al discloses as is set forth above but does not specifically disclose the lens further comprising a scratch-resistant coating. However, the examiner takes Judicial Notice of the fact that it is well known in the art of ophthalmic lenses to impart the lenses with scratch-resistant coatings. Regardless, Brown et al discloses that the lenses can be formed of polycarbonate materials (column 7, line 12). Burzynski teaches that polycarbonate ophthalmic lenses can be imparted with a scratch-resistant coating in order to impart scratch-resistant properties to the lens (column 1, line 15-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lenses of Brown et al imparted with a scratch-resistant coating since it is well known in the art of ophthalmic lenses to impart ophthalmic lenses with scratch-resistant coatings and since Burzynski teaches that polycarbonate ophthalmic lenses can be imparted with a scratch-resistant coating in order to impart scratch-resistant properties to the lens.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wertheim in view of Claussen et al.

Wertheim discloses as is set forth above but does not disclose the coloring as opaque. Claussen et al teaches that dyed ophthalmic lenses can be in the form of opaque black lenses for the purpose of providing lenses that function as sleeping aids (abstract, column 1, line 24). Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to have the dye of Wertheim in the form of an opaque dye since Claussen et al teaches that dyed ophthalmic lenses can be in the form of opaque black lenses for the purpose of providing lenses that function as sleeping aids.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al in view of Watanabe et al.

Ono et al discloses as is set forth above but does not specifically disclose the lens colored to match the coloring of the eyeglass frame. Watanabe et al teaches that colored eyeglass lenses can be colored to match the coloring of the eyeglass frame for fashion-related purposes (column 1, lines 26-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens colored to match the coloring of the eyeglass frame since Watanabe et al teaches that colored eyeglass lenses can be colored to match the coloring of the eyeglass frame for fashion-related purposes.

#### ***Prior Art Citations***

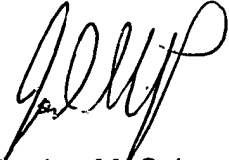
Ripley is being cited herein to show an ophthalmic lens that would read on a number of the above-referenced claims, however, such rejections would have been repetitive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz  
Patent Examiner  
Art Unit 2873  
August 23, 2001